REMARKS

In the Office Action, the Examiner noted that claims 14-26 were pending in the application; claims 14-16, 18 and 19 were rejected under the second paragraph of 35 U.S.C. § 112, but would be allowable if amended to overcome this rejection; claims 17 and 26 were rejected under 35 U.S.C. § 102(e); and claims 20-25 were allowed. In rejecting the claims, U.S. Patent 6,548,118 to Russell et al. (Reference A in the September 11, 2003 Office Action) was cited. Claims 14-26 remain in the case. The Examiner's rejections are traversed below.

Rejections under 35 U.S.C. § 112, Second Paragraph

In item 2 on page 2 of the Office Action, claims 14-16, 18 and 19 were rejected under the second paragraph of 35 U.S.C. § 112 due to lack of antecedent basis for "the data words" on lines 9 and 8 of claims 14 and 18, respectively. Claims 14 and 18 have been amended in response to this rejection. If further amendment is re needed to meet the requirements of 35 U.S.C. § 112, the Examiner is respectfully requested to contact the undersigned by telephone to arrange an Examiner Interview for the purpose of expediting appropriate amendments.

Rejections under 35 U.S.C. § 102(e)

In item 4 on page 3 of the Office Action, claims 17 and 26 were rejected under 35 U.S.C. § 102(e) as anticipated by Russell et al. Claim 26 has been amended to add "excluding overhead information" (claim 26, line 3). This limitation is supported by the first sentence of paragraph 21 on page 3 of the Substitute Specification filed December 3, 2001, which states that "the overhead information OH is first of all removed from the STM-N signal in a first demultiplexer DM2, and individual first signal sequences VC-4 are formed from the signals." Furthermore, claim 17 has been amended so that the elements recited therein generate the respective signals using the method recited in claim 26.

Since "overhead information" is excluded by the extracting step recited in claim 26 and first demultiplexer recited in claim 17, the first signal sequence used to form the reduced data rate 8B/9B signal has no information on which to detect frame boundaries. On the other hand, in the receive mode, the SDH/SONET payload mapper taught by Russell et al. receives "packet data frames ... which have their boundaries marked by start of data frame and end of data markers" (column 8, lines 43-45). Such markers constitute overhead information which is required by the payload mapper in receive mode, since "having identified the start and end boundaries of each data frame[, the payload mapper] extracts those data frames" for decoding. As described in the specification and now recited in claims 17 and 26, all overhead information, including data

frame start and end markers, is removed in the first operation recited in these claims and thus the start and end data frame markers are unavailable to the demapper recited in claim 17 or the forming operations recited in claim 26. Therefore, claims 17 and 26 patentably distinguish over Russell et al. for the reasons recognized in allowing claims 14, 18, 20 and 22. Thus, withdrawal of the rejection is respectfully requested.

Summary

It is submitted that Russell et al. does not teach or suggest the features of the present claimed invention as recited in claims 17 and 26 and that claims 14-16, 18 and 19 meet the requirements of 35 U.S.C. § 112, second paragraph. Thus, it is submitted that claims 14-19 and 26, as well as claims 20-25 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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